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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/774,929	02/09/2004	Gale H. Thorne	57435.0002	8850
57600	7590	07/01/2008		
HOLLAND & HART LLP 60 E. South Temple, Suite 2000 P.O. Box 11583 Salt Lake City, UT 84110				
EXAMINER				
ERIZO, DARWIN P				
ART UNIT		PAPER NUMBER		
3773				
MAIL DATE		DELIVERY MODE		
07/01/2008		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/774,929

**Applicant(s)**

THORNE ET AL.

**Examiner**

Darwin P. Erez

**Art Unit**

3773

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 01 April 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 4.5.7 and 11-21 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 4.5.7 and 11-21 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-8508)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_
- Paper No(s)/Mail Date \_\_\_\_\_

### DETAILED ACTION

1. This Office action is in response to the applicant's amendment filed on 4/1/08.

#### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
  2. Ascertaining the differences between the prior art and the claims at issue.
  3. Resolving the level of ordinary skill in the pertinent art.
  4. Considering objective evidence present in the application indicating obviousness or nonobviousness.
4. Claims 4, 5, 7, 11, 16-18 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over US 6,402,770 to Jessen in view of US 6,048,354 to Lawrence.

Jessen discloses a scalpel comprising: a housing **11**; a split scalpel blade **21** having a pair of sharpened points, said blade being within the housing; and an actuator **15, 17** comprising a plurality of blade interfacing parts by which the scalpel blade is manually displaced relative to the housing and to cause the blade to lance.

Jessen is silent with regards to the housing having an entry portal and an exit portal for receiving a guidewire. However, Lawrence discloses a similar cutting device, wherein the device has a housing that receives a needle **30**, which is used as a

guidewire, to accurately guide the blade near the position of the needle. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the housing of Jessen to include a channel for a guidewire because it would more accurately place the incision at the desired location.

Jessen further discloses the scalpel blade being medially split to comprise two scalpel components **24** with a common hinge connection **22**; wherein the housing comprises at least one stop **23** for limiting travel of the scalpel blade components, thereby limiting depth of the lance and ending a first lancing motion of the scalpel; wherein the housing comprises a top part and a bottom part; wherein the modification to include a channel for the guidewire; wherein the device further includes a spring **14**.

5. Claims 12-14, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Jessen in view of Lawrence, and in further view of US 5,571,132 to Mawhirt et al.

The above combination of Jessen/Lawrence discloses all the limitations of the claims except for a living hinge connecting the parts together. However, living hinge connection between housing parts are well known in the surgical art, as shown by Mawhirt in Fig. 2E. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made add a living hinge between the top and bottom parts of Jessen because such type of connection is well known in the art, as disclosed by Mawhirt.

6. Claim 15 is rejected under 35 U.S.C. 103(a) as being unpatentable over Jessen in view of Lawrence, and in further view of US 4,730,613 to Gordy.

The above combination of Jessen/Lawrence teaches all the limitations of the claim except for the device having a depth adjustable nose guard. However, Gordy discloses a similar type of cutting device, wherein an adjustable nose guard is provided to adjust the depth of the blade. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the device of Jessen to have an adjustable nose guard because it would allow the user to control the depth penetration of the blade.

***Response to Arguments***

7. The applicant's replacement abstract filed on 4/1/08 is acceptable and has been entered into the application.
8. The applicants cancellation of claims 6 and 8-10 have rendered the claim objections and claim rejections under 35 USC 112, 2nd paragraph moot.
9. Applicant's arguments regarding the claim rejections under 35 USC 103(a) have been fully considered but they are not persuasive.

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, the motivation

comes from the Lawrence '354 reference, which provides reasons for desiring a guidewire in a cutting device as stated in the rejections above.

The applicant argued that Jensen discloses his invention as being used for emergency management of upper airway obstructions and chest injuries. However, these are intended-use limitations. The device of Jensen is fully capable of being used as a cutting device in various types of surgeries that require cutting in the internal cavity of the body. Therefore, it would be obvious to provide a guidewire to said cutting device in order to deliver the cutting device to the desired location. Furthermore, a guidewire can still be used during an emergency procedure.

#### ***Conclusion***

10. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Darwin P. Erezó whose telephone number is (571)272-4695. The examiner can normally be reached on M-F (8:00-4:30).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jackie Ho can be reached on (571) 272-4696. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Darwin P. Erezó/  
Primary Examiner, Art Unit 3773